

REMARKS

Applicant hereby responds to the Final Office Action of February 22, 2008, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

Status of Claims

Claims 20-32 are currently pending. Claims 20, 28 and 32 are independent.

Claims 20-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,758,257 ("Herz") in view of U.S. Patent No. 6,704,931 ("Shaffer").

Drawings

Applicant respectfully requests that the Examiner indicates acceptance of the formal drawings.

Claim Amendments

By way of this reply, claims 20, 28 and 32 have been amended for clarification. No new matter has been added. In addition, none of the amendments changes the scope of the claims. Thus, no new search is necessary.

Rejection under 35 U.S.C. §103(a)

Rejection of claims 20-32 is respectfully traversed because, for at least the following reasons, Herz and Shaffer, whether considered separately or in combination, fail to show or suggest all of the claimed limitations.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that

‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Additionally, according to MPEP §2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

The claimed invention is directed to a system and method for personalizing TV. Independent claim 20 requires, in part, “presenting the viewer with a *first list of TV programs* available for viewing, the programs selected and arranged in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer after viewing the first list, the input requesting different selections than in the first list*; and presenting the viewer

with *a second list including alternative TV programs available for viewing*" (emphasis added). Independent claim 28 requires, in part, "presenting the viewer with one of *a first list of the selected programs and an alternative second list of programs*, the first list arranged in accordance with the viewer characteristics information profile, and the second list arranged in accordance with an alternate viewer characteristics information profile, wherein *the second list is based on feedback input from the viewer of the first list*" (emphasis added). Independent claim 32 requires, in part, "presenting the viewer with a first list of the selected programs, the first list arranged without viewer input in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer about the first list*; and *presenting the viewer with a second list of selected programs based on said feedback input*" (emphasis added).

Herz and Shaffer, whether considered separately or in combination, fail to disclose or suggest at least the above-mentioned limitations.

It is asserted in the Office Action that Herz discloses presenting the viewer with a list of alternative TV programs as more than one alternative characteristics information profile maybe stored. While Herz may provide an alternative profile, Herz does not teach, disclose or suggest that the alternative profile is based on viewing a first list and providing feedback from the user to provide the alternative list. Col. 45, lines 34-67 of Herz (relied upon in the instant Office Action) reads:

... a list of "preferred channel selections" or "virtual channels" is determined. ... Once the customer has selected the desired virtual channel from a highlighted program guide or a listing of the programs available on the virtual channels using the customer's remote control unit, processor 906 then accordingly instruct channel selector 912 to tune the channels for the programming determined in accordance with the techniques of the invention to be most desirable to that customer. ...

As noted above, numerous customer profiles may be stored at each set top multimedia terminal, each corresponding to a different customer and/or mood of the customer or customers. ... In other words, the customer identifier functional block 918 may be used to differentiate multiple customers or to override the mood indicator 910 to allow the customer to select a different profile than that which would otherwise be recommended

From the above passage, it is clear that according to Hertz *only one set* of recommended programs *is presented*, and is presented only after the customer selects a profile. This is contrary to the claimed limitations discussed above, wherein the viewer is given the opportunity of providing a feedback *after* being presented with a program list based on a viewer characteristics information profile, and *then* being presented with an alternative list based on an alternative viewer characteristics information profile.

Schaffer, like Herz discussed above, also fails to show or suggest at least the above-mentioned limitations, and fails to supply that which Herz lacks. This is also evidenced by the fact that Schaffer is relied upon in the instant Office Action merely to supply a list of arranged TV programs. Further, Shaffer displays programs based on the total recommendation scores of each *channel, rather than the claimed* display of programs based on program rating.

Further, Applicant respectfully submits that there is no reason, motivation or suggestion to combine Herz and Schaffer, and that Herz teaches away from the claimed invention. The teachings of Herz discussed above, particularly, with respect to only one set of recommended programs being presented *after* the customer selects a profile, are intended for blocking certain channels, such as adult channels, thereby preventing children from viewing such channels or even learning about the very existence of such channels. Had Herz and Schaffer been combined and modified to arrive at the claimed invention, the modified system would allow children to be presented with at least a list of undesirable programs such as adult programs, before viewer input is received and subsequently an alternative list is presented. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, this would also change the principle of operation (see MPEP 2143.01 VI, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Even if Herz is combined with Shaffer, the resulting invention would fail to teach or suggest Applicant's amended claim 20 limitations of "presenting the viewer with *a first list of TV programs* available for viewing, the programs selected and arranged in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer after viewing the first list, the input requesting different selections than in the first list*; and presenting the viewer with *a second list including alternative TV programs available for viewing*" (emphasis added) Applicant's amended claim 28 limitations of "presenting the viewer with one of *a first list of the selected programs and an alternative second list of programs*, the first list arranged in accordance with the viewer characteristics information profile, and the second list arranged in accordance with an alternate viewer characteristics information profile, wherein *the second list is based on feedback input from the viewer of the first list*" (emphasis added), or Applicant's amended claim 32 limitations of "presenting the viewer with a first list of the selected programs, the first list arranged without viewer input in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer about the first list*; and *presenting the viewer with a second list of selected programs based on said feedback input*" (emphasis added).

Further, the assertions made in the Office Action on pages 5 and 6 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. Additionally, since neither Herz, Shaffer, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 20, 28 and 32, as listed above, Applicant's amended claims 20, 28 and 32 are not obvious over Herz in view of Shaffer since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 20 and 25, namely claims 21-24, and 26-31, respectively, would also not be obvious over Herz in view of Shaffer for the same reason.

Accordingly, withdrawal of the rejection of claims 20-32 is respectfully requested.

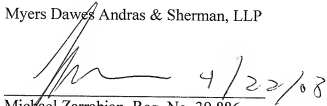
CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that the rejections of the claims be withdrawn, and that the case be passed to issue. If the Examiner feels that a telephone interview would be helpful to the further prosecution of this case, Applicant respectfully requests that the undersigned attorney be contacted at the listed telephone number.

Please direct all correspondence to **Myers, Dawes Andras & Sherman, LLP**, 19900 MacArthur Blvd., 11th Floor, Irvine, California 92612.

Respectfully submitted,

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